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IN THE

Supreme Court of the United States

OCTOBER TERM, 1951

No. 727

AIR PRODUCTS, INC.,
Petitioner,

vs.

BOSTON METALS COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT AND BRIEF IN SUPPORT THEREOF

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INDEX

Table of Contents

	PAGE
Preliminary Statement	1
Opinions Below	2
Jurisdiction	2
Questions Presented	2
Specification of Errors to be Urged	3
Reasons for the Allowance of the Writ	3
Brief	5-9
The Court Below Concedes That Anderson Achieved His Objective by a Method Never in the Form Employed by Anderson Theretofore Used	5
The Claimed Method of Anderson is Not Taught by the Prior Art	6
The Court of Appeals Failed to Apply the Controlling Decision of this Court	8
Conclusion	9
Appendix	11-13
Part I	11
Part II	12

Table of Authorities Cited

Apel v. Connolly, 95 Fed. Supp. 160	12
Air Devices, Inc. v. Air Factors, Inc. et al, 94 Fed. Supp. 819	12
Associated Folding Box Co., Inc. et al v. Levkoff et al, 92 USPQ 193, ... Fed. (2d)	13

PAGE

Berry et al v. Kemline Metal Products Co., Inc., 191 Fed. (2d) 258 12

Bryant Electric Co. v. Industrial Electronics Corp., 96 Fed. Supp. 601 12

Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403 ..... 2, 3, 8, 9

Container Co. v. Carpenter Container Corp., et al, 99 Fed. Supp. 167, aff'd. 93 USPQ 60 13

Franz et al, Application of, 190 Fed. (2d) 86 12

General Bronze Corp. v. Cupples Products Corp., et al, 189 Fed. (2d) 154 12

Gerry et al v. International Latex Corp., 90 USPQ 250, ... Fed. Supp. 13

Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corporation, 340 U. S. 147 ..... 3, 4, 8, 9

Grinoch v. Tuxton Cravats, Inc., 92 USPQ 208, ... Fed. Supp. 13

Hamilton v. Rogers et al, 90 USPQ 19, ... Fed. Supp 13

Hamilton Mfg. Co. v. Illinois Surgical Supply et al, 97 Fed. Supp. 235 13

Hutchinson Mfg. Co., The v. Mayrath, 192 Fed. (2d) 110, cert. den. Mar. 31, 1952, ... S. Ct. 12

Ingersoll-Rand Co. et al v. Black & Decker Mfg. Co., 192 Fed. (2d) 270, cert. den. Mar. 31, 1952, ... S. Ct. 12

Karl Kiefer Mach. Co. v. U. S. Bottlers Mach. Co., C. A. 7, 114 Fed. (2d) 169 8

Kleinman v. Betty Dain Creations, Inc., 189 Fed. (2d) 546 12

Kono Mfg. Co. v. Vogue Optical Mfg. Co., Inc., 94 Fed. Supp. 251 12

Laclede-Christy Co. v. Union Fire Brick Co. et al, 98 Fed. Supp. 710 13

	PAGE
Laurent, In re, 186 Fed. (2d) 741	11
Lebold et al v. Marzall, 91 USPQ 332, Fed. Supp.	13
Lenox v. Landers, 188 Fed. (2d) 744	11
Martin et al v. Wyeth, Inc., et al, 96 Fed. Supp. 689	12
McCord Corp. v. Beacon Auto Radiator Co., Inc., 96 Fed. Supp. 438, aff'd. 92 USPQ 163	12
Metropolitan Body Co. v. Divco Corp., 94 Fed. Supp. 731	12
Montgomery Ward & Co. v. Buer, 186 Fed. (2d) 614	11
Nachman Corp. v. L. A. Young Spring & Wire Corp., 92 USPQ 24, Fed. Supp.	13
Norris Dispensers, Inc. v. Ohleen Dairy Co. et al, 88 USPQ 65, Fed. Supp.	13
Otis v. Marzall, 189 Fed. (2d) 653	12
Packwood v. Briggs & Stratton Corp. et al, 99 Fed. Supp. 803	13
Paramount Industries, Inc. v. Solar Products Corp. et al, 186 Fed. (2d) 999	11
Park-In-Theatres v. Perkins et al, 190 Fed. (2d) 137	12
Pennsylvania Crusher Co. et al v. Bethlehem Steel Co. et al, 92 USPQ 31, Fed. (2d)	13
Photochart et al v. Photo Patrol, Inc. et al, 189 Fed. (2d) 625, cert. den. 72 S. Ct. 107	12
Red Devil Tools v. Hyde Mfg. Co., 96 Fed. Supp. 502, aff'd. 92 USPQ 27	12
Russell, F. C. v. Comfort Equipment Corp. et al, 97 Fed. Supp. 784	13
Schreyer et al v. Casco Products Corp., et al, 97 Fed. Supp. 159, rev. 190 Fed. (2d) 921	12
Shell et al v. Electric Auto Lite Co., 98 Fed. Supp. 462	13
Spring-Air Co. v. Ragains, 96 Fed. Supp. 79	12
Stephens Products Co., Inc. v. Fillum Fun, Inc., 99 Fed. Supp. 649	13
Turini v. Allens Mfg. Co., Inc., 100 Fed. Supp. 61	13

PAGE

United Specialties Co. et al v. Industrial Wire Cloth Products Corp., 186 Fed. (2d) 426 11

United States v. Dubillier Condenser Corp., 289 U. S. 178, 188 8

Van Der Horst Corp. of America v. Chromium Corp. of America, 98 Fed. Supp. 412 13

Vapor Blast Mfg. Co. et al v. Pangborn Corp., 186 Fed. (2d) 230 11

Wabash Corp. et al v. Ross Electric Corp. et al, 187 Fed. (2d) 577, cert. den. 72 S. Ct. 38 11

Watson et al v. Heil et al, 96 Fed. Supp. 61 12

Youngs Rubber Corp. v. Allied Latex Corp., 188 Fed. (2d) 945, cert. den. 72 S. Ct. 86 11

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vs.

BOSTON METALS COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioner, Air Products, Incorporated, respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fourth Circuit in the above-entitled case.

A certified transcript of the record, including the proceedings in said Court of Appeals, is furnished herewith in compliance with Rule 38 of the Rules of this Court.

OPINIONS BELOW

The opinion of the District Court for the District of Maryland holding method claims 11, 13 and 19 of Anderson Patent 2,480,093 valid and infringed (R. I, 80) is reported at 98 Fed. Supp. 719. The opinion of the Court of Appeals for the Fourth Circuit dated January 4, 1952 reversing the District Court and holding the claims in suit invalid (R. III, 39) is reported at 193 F. (2d) 535. Rehearing was denied by the Court of Appeals on March 10, 1952 (R. III, 61).

JURISDICTION

The jurisdiction of the Court is invoked under Section 240(a) of the judicial code as amended June 25, 1948, effective September 1, 1948 (28 U. S. C., Sect. 1454 (1)) and under Section 5 (b, 1) of Rule 38 of this Court.

The pertinent patent statute is 35 U. S. C. 31; R. S. 4886, set forth in Part I of Appendix hereto.

QUESTIONS PRESENTED

The judgment of the Court of Appeals for the Fourth Circuit raises the following questions of law:

Question 1 — Is the doctrine of *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403 to the effect that,

> ". . . a process patent can only be anticipated by a similar process. It is not sufficient to show a piece of mechanism by which the process *might* have been performed."

still law and applicable to process claims defining a combination of process steps yielding a new coaction and an advantageous, novel result not previously known to the art?

Question 2 — Does the doctrine of *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 require a holding of noninvention with respect to method claims defining a combination of method steps in a relationship yielding a new coaction and producing a new result not previously known to the art where the elements of the apparatus employed in practicing the method are admittedly old?

SPECIFICATION OF ERRORS TO BE URGED

The Court of Appeals erred:

1. In holding the method claims in suit invalid on the basis of prior art which, while lacking a teaching of the claimed method, discloses apparatus which *might*, by *modification*, be employed for carrying out the novel and efficacious claimed method.

2. In failing to apply and follow the rule as to the patentability of method claims laid down by this Court in *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403 and in failing to find that the Anderson method fully meets the test of invention laid down in this Court's decision in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147.

3. In reversing the judgment of the District Court.

REASONS FOR THE ALLOWANCE OF THE WRIT

1. The opinion of the Court of Appeals failed to apply the controlling decisions of this Court and, more specifically, the decision in *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403.

2. The opinion of the Court of Appeals misconstrued and misapplied the decision of this Court in *Great Atlantic &*

Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147.

3. The judgment of the Court of Appeals should be reviewed to the extent that it places reliance upon the decision of this Court in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 which is ripe for review and clarification by this Court.

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BRIEF IN SUPPORT OF PETITION

Suit was brought by petitioner against respondent for infringement of Anderson U. S. Patent No. 2,480,093 issued August 23, 1949. At the trial suit was restricted to claims 11, 13 and 19 of the patent addressed to a method for producing oxygen from atmospheric air. Before the Court of Appeals infringement was conceded. The sole question is the validity of method claims 11, 13 and 19 of the Anderson patent.

Atmospheric air, after liquefaction, may be fractionally distilled at low temperatures. Its oxygen content boils at 183° below zero Centigrade and its nitrogen content at about 196° below zero Centigrade at atmospheric pressure. As to the method claims in suit, the significant object of the Anderson invention is:

> ". . . to provide a method and means for pumping liquefied oxygen directly from a pool of commercially pure oxygen in a fractionating tower to cylinders or pipe lines in which gaseous oxygen is transported under high pressure, thereby avoiding the requirement for an oxygen storage tank and a gaseous oxygen compressing system" (R. I., 115).

The Court Below Concedes That Anderson Achieved His Objective by a Method Never in the Form Employed by Anderson Theretofore Used.

Of the Anderson contribution the Court of Appeals said:

> "To sum up, . . . it appears that Anderson was the first person to produce high pressure oxygen gas and deliver it to receptacles in one process without the use of an intermediate receptacle between the fractionating column and the ultimate containers; that this was accomplished by a method never in the precise form employed by Anderson theretofore used, viz., pumping liquid oxygen which had been withdrawn from the

fractionating column to a high pressure and avoiding vapor lock in the pump by sub-cooling the oxygen and the pump by the use of nitrogen gas from the top of the fractionating column; and that this process entered into immediate use and achieved commercial success" (R. III, 46).

Anderson conceived and produced a new relationship and a new coaction of process steps by which a novel, double use of that refrigerating value in the gaseous nitrogen from the air fractionating column employed to subcool liquid oxygen is made; (1) a first use in cooling the liquid oxygen to permit it to be pumped to high pressure and, (2) a second use of the same cold by using the subcooled oxygen to cool the infed air.

The novel, double use of the same refrigerating value in the nitrogen gas from the air fractionating column had never been disclosed or suggested prior to Anderson.

The Claimed Method of Anderson is Not Taught by the Prior Art.

The method claims were held invalid by the Court of Appeals over prior art which at best discloses apparatus which might be modified so as to permit the practice of the Anderson method but which does not teach that method.

As to the German Polard Patent 495,795, the District Court found that:

"... Polard in no sense discloses the cooling method of Anderson because the pumping and cooling of the liquid oxygen in Polard is no way connected with the column operation or caused by any column product. Like Hansen, it is a wasteful and therefore not a practical method for pumping liquid oxygen from a rectifying column, ..." (R. I, 91).

The District Court found that:

> ". . . Eichelman does not disclose the method and apparatus of Anderson any more than does Von Recklinghausen" (R. I, 89).

The Von Recklinghausen patent was abandoned by respondent as a defensive item before the Court of Appeals.

As to the Hansen patent 2,292,375, the District Court found:

> "This system . . . is similar to that disclosed by Polard . . . It clearly is not in any sense a disclosure of Anderson's method of sub-cooling, since the cooling of the liquid oxygen is entirely divorced from a column operation, and the refrigeration latent in the gaseous nitrogen or in any other product of the column is not used" (R. I, 90).

As to the German Messer and Grassmann Patent 712,480, the District Court found:

> ". . . there is no disclosure in this German patent of either of the two steps taught by Anderson to avoid vapor-lock in pumping directly from the pool in the fractionating columns without the interposition of a storage vessel" (R. I, 91).

Additionally, the District Court said of this patent:

> "The weight of the more credible testimony with respect to this Messer and Grassmann patent confirms, as the Court believes, witness Twomey's interpretation of it to the effect that the pump referred to being a suction pump, the purpose of it is to exhaust, by suction, the gas out of the receiving container, thereby syphoning the liquid oxygen from the storage container — in other words, a pumping process entirely different from the process employed by Anderson with respect to the liquid oxygen" (R. I, 92).

The District Court said, inter alia:

> "The act of invention consists in discovering how certain natural laws, as in this case, the laws of chemistry and physics, may be applied for a beneficial purpose. 'It is the result of an inventive act, the birth of an idea and its reduction to practice; the product of original thought; a concept demonstrated to be true by practical application or embodiment in tangible form.' *United States v. Dubillier Condenser Corp.*, 289 U. S. 178, 188. While the Supreme Court very recently in *A. & P. Tea Co. v. Supermarket Corp.*, 340 U. S. 147, has announced that the lower Courts have been too prone to adopt a standard of invention in certain types of cases involving combinations of elements that is not sufficiently exacting, we believe that the conclusion which we here reach with respect to the Anderson patent is entirely consistent with that decision" (R. I, 95).

The District Court held the method claims in suit valid, which holding is in strict conformity with the doctrine of the *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403 decision of this Court and consistent with the application of that doctrine in such cases as *Karl Kiefer Mach. Co. v. U. S. Bottlers Mach. Co.*, C. A. 7, 114 Fed. (2d) 169.

The Court of Appeals Failed to Apply the Controlling Decision of this Court.

The Court of Appeals refused to follow the doctrine laid down in the *Carnegie Steel Co. v. Cambria Iron Co. supra* decision and, despite the affirmative findings of fact of the District Court and its rulings consistent with the applicable tests of invention laid down by this Court, reversed the District Court on the issue of invention holding, inter alia, that:

"Quite germane here is the opinion of Mr. Justice Jackson in the very important case of *Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corporation*, 340 U. S. 147."

The Court of Appeals fell into clear error in failing to apply to the facts of this case the doctrine laid down by this Court in *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403 and in misinterpreting and misapplying the decision of this Court in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147 and decisions of inferior courts to the same effect.

The decision of this Court in the *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, case has figured in the disposition of a very large number of patent cases[1] and much confusion now exists in the construction and manner of application of the decision of this Court in that case which, in the public interest, is ripe for review and clarification.

CONCLUSION

For the foregoing reasons petitioner prays that its petition for writ of certiorari be granted.

Respectfully submitted,

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[1] Citations enumerated infra Appendix Part II. pp. 11-13.

APPENDIX

Part I

35 U. S. C. 31; R. S. 4886. *Inventions patentable.*

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or *any new and useful improvements thereof,* * * * not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (R. S. sec. 4886; Mar. 3, 1897, ch. 391, sec. 1, 29 Stat. 692; May 23, 1930, ch. 312, sec. 1, 46 Stat. 376; Aug. 5, 1939, ch. 450, sec. 1, 53 Stat. 1212). (Emphasis supplied).

Part II

Vapor Blast Mfg. Co. et al v. Pangborn Corp., 186 Fed. (2d) 230

United Specialties Co. et al v. Industrial Wire Cloth Products Corp., 186 Fed. (2d) 426

Montgomery Ward & Co. v. Buer, 186 Fed. (2d) 614

In re Laurent, 186 Fed. (2d) 741

Paramount Industries, Inc. v. Solar Products Corp. et al, 186 Fed. (2d) 999

Wabash Corp. et al v. Ross Electric Corp. et al, 187 Fed. (2d) 577, cert. den. 72 S. Ct. 38

Lenox v. Landers, 188 Fed. (2d) 744

Youngs Rubber Corp. v. Allied Latex Corp., 188 Fed. (2d) 945, cert. den. 72 S. Ct. 86

General Bronze Corp. v. Cupples Products Corp. et al, 189 Fed. (2d) 154

Kleinman v. Betty Dain Creations, Inc., 189 Fed. (2d) 546

Photochart et al v. Photo Patrol Inc. et al, 189 Fed. (2d) 625, cert. den. 72 S. Ct. 107

Otis v. Marzall, 189 Fed. (2d) 653

Application of Franz et al, 190 Fed. (2d) 86

Park-In-Theatres v. Perkins et al, 190 Fed. (2d) 137

Berry et al v. Kemline Metal Products Co., Inc., 191 Fed. (2d) 258

The Hutchinson Mfg. Co. v. Mayrath, 192 Fed. (2d) 110, cert. den. March 31, 1952, ... S. Ct. ....

Ingersoll-Rand Co. et al v. Black & Decker Mfg. Co., 192 Fed. (2d) 270, cert. den. March 31, 1952, ... S. Ct. ....

Kono Mfg. Co. v. Vogue Optical Mfg. Co., Inc., 94 Fed. Supp. 251

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Air Devices, Inc. v. Air Factors, Inc. et al, 94 Fed. Supp. 819

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Watson et al v. Heil et al, 96 Fed. Supp. 61

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Bryant Electric Co. v. Industrial Electronics Corp., 96 Fed. Supp. 601

Martin et al v. Wyeth, Inc. et al, 96 Fed. Supp. 689

Schreyer et al v. Casco Products Corp., et al, 97 Fed. Supp. 159, rev. 190 Fed. (2d) 921

Hamilton Mfg. Co. v. Illinois Surgical Supply, et al, 97 Fed. Supp. 235

F. C. Russell v. Comfort Equipment Corp., et al, 97 Fed. Supp. 784

Van Der Horst Corp. of America v. Chromium Corp. of America, 98 Fed. Supp. 412

Shell et al v. Electric Auto Lite Co., 98 Fed. Supp. 462

Laclede-Christy Co. v. Union Fire Brick Co., et al, 98 Fed. Supp. 710

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Turini v. Allens Mfg. Co., Inc., 100 Fed. Supp. 61

Norris Dispensers, Inc. v. Ohleen Dairy Co., et al, 88 USPQ 65, ... Fed. Supp. .....

Hamilton v. Rogers, et al, 90 USPQ 19, ... Fed. Supp. .....

Gerry et al v. International Latex Corp., 90 USPQ 250, ... Fed. Supp. .....

Lebold et al v. Marzall, 91 USPQ 332, ... Fed. Supp. .....

Nachman Corp. v. L. A. Young Spring & Wire Corp., 92 USPQ 24, ... Fed. Supp. .....

Pennsylvania Crusher Co. et al v. Bethlehem Steel Co., et al, 92 USPQ 31, ... Fed. (2d) .....

Associated Folding Box Co., Inc., et al v. Levkoff, et al, 92 USPQ 193, ... Fed. (2d) .....

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BRIEF FOR RESPONDENT IN OPPOSITION

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INDEX

	PAGE
Opinions Below	1
Jurisdiction	1
Statement	1-4
Argument	4-6
Conclusion	6

Cases Cited

Air Products v. Boston Metals Co. (D. C. Md.), 98 F. Supp. 719	1
A. & P. Tea Co. v. Supermarket Corp., 340 U. S. 147	5, 6
Boston Metals Co. v. Air Products (C. C. A., 4th Cir.), 193 F. 2d 535	1
Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403	5, 6
Dow Co. v. Halliburton Co., 324 U. S. 320	6
Jungersen v. Ostby & Barton Co., 335 U. S. 560	6

Statute

28 U. S. C. A. § 1254(1)	1

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BRIEF FOR RESPONDENT IN OPPOSITION

Opinions Below

The opinion of the District Court for the District of Maryland (R. I, p. 80) is reported in 98 F. Supp. 719. The opinion of the Court of Appeals for the Fourth Circuit (R. III, p. 39) is reported in 193 F. 2d 535.

Jurisdiction

Petitioner* invokes the jurisdiction of this Court under 28 U. S. C. A. § 1254(1).

Statement

The sole issue below was whether Claims 11, 13 and 19 of Air Products' Anderson patent No. 2,480,093 were valid.

The Court of Appeals held they were not.

* Petitioner is hereinafter referred to as "Air Products"; Respondent as "Boston Metals." Parentheses and italics within quotes are ours unless the contrary is indicated.

The Anderson patent, entitled "Method of and Apparatus for Pumping Liquid Oxygen" (R. I, pp. 109-119) discloses both an apparatus and a method for the separation of oxygen from the other constituents of the air and storing the oxygen, as a high pressure gas, in the familiar heavy steel cylinders, four to five feet tall and about nine inches in diameter, in which it frequently is marketed.

The entire apparatus and each step of the fractionating, pumping and storing operations are in the prior art, as, in substance, the Anderson patent concedes (R. I, p. 115: c. 2, ll. 25-26, 35-36; p. 116: c. 4, ll. 18-20). However, the patent notes that "The step of pumping liquid oxygen has proven in practice to be one of great difficulty." This, it says, grows from the fact that friction in the pump creates heat in the liquid oxygen which brings the oxygen above its boiling point, thus turning it into a gas "which locks the suction and puts the pump out of commission" (R. I, p. 116: c. 3, ll. 62-75). To correct this "difficulty" Anderson employs the very cold nitrogen gas which is derived from the separation operation and which is largely a waste product, to reduce the temperature of the oxygen in advance of the pump* so that the pump friction cannot heat the oxygen to its boiling point. This is known as "subcooling."

This is the sum of the asserted novelty of the patent in suit (see R. I, p. 116: c. 4, ll. 7-15). At most it is an improvement on a single step in an old process.

The claims in issue, however, are not restricted to this step but go, broadly, to the steps of drawing liquid oxygen from the column, subcooling it by nitrogen from the column, pumping it and converting it to a gas (R. I, pp. 118-119).

In the Court of Appeals, Boston Metals relied particularly on the German Polard patent No. 495,795 of 1930

* The patent describes a further step not relevant to the claims in issue.

and on Eichelman patent No. 1,976,388 of 1934 and German Messer & Grassmann patent No. 712,480 of 1941. The Polard and the German Messer patents recognized the pumping "difficulty" to which Anderson addressed himself and showed precisely Anderson's means of overcoming that "difficulty."

The Polard patent would be a blanketing anticipation of Anderson except for a detail which the Court of Appeals referred to as follows (R. III, p. 42):

> "Polard mentions apparatus for pumping liquid oxygen from a pool in 'a container;' Anderson mentions pumping liquid oxygen from a pool in the 'column.' It is open to question whether Polard is limited to pumping from a particular type of container; also whether Anderson is strictly limited to pumping from the column."

The Court might have been more categorical, for Polard and Anderson show that neither is so limited. Polard taught that his means of subcooling the oxygen in advance of the pump could "be generally used" (R. I, p. 175: ll. 44-47), and Anderson explicitly stated that his method was applicable to pumping from a storage container (R. I, p. 115: c. 1, ll. 4-8) as well as from the column, thus demonstrating that the operation is not affected by the nature of the container from which the oxygen is pumped. Clearly, therefore, the Court of Appeals was justified in its conclusion that—

> "In any event, this difference, *if it exists,* is neither vital nor sufficient to constitute patentable invention" (R. III, p. 42).

The Eichelman patent (R. I, pp. 153-156) showed every element of Anderson and every step of the method of Anderson. Its pumping step, however, *may* have been liable to vapor-lock. But, as the Court of Appeals said, "the problem of vapor-lock had been solved by Polard, Hansen and Messer and Grassmann" (R. III, pp. 42-43; see also,

R. I, pp. 172-177, 163-171, 178-183). And, again in the words of the Court of Appeals—

> "Unlike Polard and Hansen, *but like Anderson,* Messer shows the liquid oxygen initially collected, not in a storage container, but in a pool in the column. Messer also shows * * * that the oxygen line runs through a heat exchanger and 'is super cooled * * * by the nitrogen flowing from the separating column directly connected with it' " (R. III, p. 43—italics by Court; see also, R. I, p. 182: ll. 66-69).

To use the method of Eichelman with its single imperfect step perfected, as taught by the German Messer patent, does not amount to invention.

The oxygen apparatus, the operation of which is here accused, was first sold by its maker thirteen months *before* the issue of Anderson patent No. 2,480,093 (R. I, pp. 20-21, 33; R. II, p. 56). It had been designed in accordance with the teachings of United States Messer patent No. 2,133,105 of 1938 (the substantial equivalent of Eichelman) and the German Messer patent, and its operation employed precisely the method of those patents (R. I, pp. 15-33).

Argument

The petition here presents no special and important reasons why the writ should be granted. There is no conflict between the decisions of any Courts of Appeals. There is no important question of Federal law involved. There is no Federal question which has been decided in a way in conflict with any decisions of this Court. And there has been no departure here from the accepted and usual course of judicial proceedings.

Air Products' petition for certiorari states that the Court of Appeals erred "In holding the method claims in suit invalid on the basis of prior art which, while lacking a teaching of the claimed method, discloses apparatus which *might,*

by *modification*, be employed for carrying out the novel and efficacious claimed method" (Petition, p. 3—italics by Petitioner).

This is factually inaccurate. The title of the Polard patent is "A *method* of handling liquefied gases by pumping" and while, like Anderson, apparatus is shown, Polard also shows *the method* of operating that apparatus. Similarly, the prior art Eichelman patent disclosed *a method* (R. I, p. 154: ll. 65-66; see also, ll. 40-54, 77-110; p. 155: ll. 1-49) identical with the method of the patent in suit except that operation at the pumping step may have caused vapor-lock. And the German Messer patent disclosed precisely the way employed by Anderson to cure vapor-lock if, in fact, it developed (R. I, p. 181: ll. 25-33; p. 182: ll. 65-72, 80-89).

Air Products goes on to assert that the Court of Appeals erred in not following the rule of *Carnegie Steel Co.* v. *Cambria Iron Co.*, 185 U. S. 403 and in failing to find that the Anderson method met the test of *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147. Air Products never suggested that the *Carnegie* case had *any* application here until following the decision of the Court of Appeals. Then, attempting to take advantage of the Court's use, on several occasions, of the words "elements" or "apparatus" instead of "steps" or "method"*—Air Products first asserted the relevance of the *Carnegie* case in its petition for rehearing. However, that case is not pertinent since the Court of Appeals did not hold the claims in suit antici-

* Thus, the Court said, "The Polard patent discloses the essential *elements* of Anderson * * *" (R. III, p. 42) and "Clearly, the essential features of the Anderson *apparatus* were all old * * *" (R. III, p. 45), but, as indicated, all the patents referred to by the Court showed not only apparatus—and elements—but also a method, and the Court of Appeals had this clearly in mind, as is shown by the balance of both quotations above. Each of these refers specifically to method (see also, R. III, p. 44) as does the discussion by the Court of Hansen (R. III, pp. 42-43) and of the German Messer patent (R. III, p. 43).

pated by "a piece of mechanism by which the process *might* have been performed" (Petition, p. 2—italics by Petitioner; cf., 185 U. S. 403, 422). Instead, the method claims were held not to represent invention over the methods of the prior patents discussed above.

The decision below exactly accords with this Court's recent decisions in *Dow Co.* v. *Halliburton Co.*, 324 U. S. 320, and *Jungersen* v. *Ostby & Barton Co.*, 335 U. S. 560.

While the *A. & P.* case dealt specifically with an apparatus patent, its statement of the law has equal application to *any* type of patent. And the following statement is entirely apposite here:

> "Patents cannot be sustained when * * * their effect is to subtract from former resources freely available to skilled artisans. * * * This patentee has added nothing to the total stock of knowledge, but has merely brought together segments of prior art and claims them in congregation as a monopoly" (340 U. S. 152-153).

Conclusion

This case presents no question of law and no question of general importance. It is controlled entirely by its own facts and those facts do not justify the grant of the writ sought.

Respectfully submitted,

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